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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,341	04/01/2004	Donald Wayne Howell	112325.133 US3	5348

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EXAMINER	
WACHSMAN, HAL D	

ART UNIT	PAPER NUMBER
2857	

DATE MAILED: 02/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/814,341	HOWELL ET AL.	
	Examiner	Art Unit	
	Hal D. Wachsman	2857	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 November 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *25-51* is/are pending in the application.

4a) Of the above claim(s) *30-34,43,44,46 and 47* is/are withdrawn from consideration.

5)☒ Claim(s) *35-37,39,41 and 48-51* is/are allowed.

6)☒ Claim(s) *25,27,38,40 and 45* is/are rejected.

7)☒ Claim(s) *26,28,29 and 42* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *01 April 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4-1-04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. Applicant's election *without* traverse of species I (claims 25-29, 35-42, 45 and 48-51) in the reply filed on 11-8-04 is acknowledged. The Examiner notes that the Applicant indicated in this election that the election is without traverse "..to the extent that it is understood that (a) the requirement will be withdrawn upon the finding of a patentable genus; and (b) any species withdrawn from consideration will be transferred to the elected subject-matter unless it is found patentably distinct from the elected or allowed claims." With respect to (a) above, the Examiner respectfully notes that as shown in paragraph 2 of the restriction requirement no claims were deemed generic. With respect to (b) above, paragraph 5 of the restriction requirement indicated, "Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case". However, election was made without traverse and no evidence was identified by the Applicant in the reply showing the species to be obvious variants and also there was no admission on the record that this is the case.

2. Claims 30-34, 43, 44, 46 and 47 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 11-8-04.

3. The Abstract is objected to because it is greater than 150 words in length. In addition, the Abstract states "capable of" which implies that the invention may or may

not do what is being stated. This same type of problem also occurs in the specification for example on pages 3 and 9. Appropriate correction is required.

4. The Related Applications section on page 1 of the specification does not provide the current status of U.S. applications 09/940,400 and 09/027,545. Appropriate correction is required.

5. Claims 25-29, 37, 39-42, 45 and 48-51 are objected to under 37 C.F.R. 1.75(a) for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. In claim 25, line 7, it appears that the word "and" is missing between the words "panel" and "includes". Claim 25, line 7, cites "energy usage" however is this the same energy usage previously cited in the claim ? Claim 27, lines 2-3, cite "an energy distribution panel" however is this the same energy distribution panel already cited in claim 25 ? Claim 28, line 2, cites "outputs" which it appears should be "outputting". Claim 37, line 3, cites "the at least two utilities meters" which it appears should be "the at least two utility meters". This same type of problem also occurs in claim 39, line 4, claim 40, line 3. Claim 39, lines 8-9, cite "the sub-measurement board" however the antecedent basis is "at least one sub-measurement board". This same type of problem also occurs in claim 39, line 13, claim 41, lines 8-9, claim 50, lines 8-9, 13 and 17, claim 51, lines 8-9. Claim 39, line 9, cites "the location" however the antecedent basis is "remote location". This same type of problem also occurs in claim 41, line 9. Claim 40, lines 3-4, cite "...an electric meter, a water meter, and a gas meter measuring the energy usage..." however there is ambiguity here as to how a water meter in itself can be used to measure the energy usage. This same type

of problem also occurs in claim 41, line 5, claim 49, line 6, claim 50, line 5, claim 51, line 5. Claim 40, line 11, cites "capable of" which implies that the invention may or may not do what is being cited in the claim. Claim 40, lines 3-4, cite "..the at least two utilities meters comprising an electric meter, a water meter, and a gas meter.." however in the situation where "the at least two utilities meters" is just two meters how can there then be all the three types of meters cited that is the electric meter, the water meter and the gas meter ? Claim 41, line 11, cites "at least one distribution panel" however is this the energy distribution panel previously referred to in the claim ? This same type of problem also occurs in claim 50, line 11, claim 51, line 11. Claim 45, line 6, cites "said energy distribution panel" which it appears should be "an energy distribution panel". This same type of problem also occurs in claim 48, line 6, claim 49, lines 8-9, claim 50, line 10, claim 51, line 10. The examiner asks the applicant to better claim the limitations cited above. While the examiner understands the intentions of the applicant he feels confusion could be drawn from the limitations cited above. Appropriate correction is required.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 25 and 27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16 and 17 respectively of U.S. Patent No. 6,728,646. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 25 is anticipated by claim 16 of U.S. patent no. 6,728,646 because the load profile in claim 16 of the patent indicates the energy usage and the outputting of this load profile which indicates the energy usage which can encompass the use of a display as cited in 25 of the instant application. In addition, the feature of dependent claim 27 in the instant application and of dependent claim 17 in U.S. patent no. 6,728,646 are the same.

8. Claim 45 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,728,646. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 45 is anticipated by claim 1 of U.S. Patent No. 6,728,646 because as the sub-measurement board in claim 1 of the patent is connected to an energy distribution panel and receives the at least three voltage signals and at least nine current signals from the energy distribution panel, this would encompass the sub-measurement board including a means for receiving at least three voltage signals and at least nine current signals from the energy distribution panel.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

10. Claim 38 is rejected under 35 U.S.C. 102(e) as being anticipated by Johnson et al. (5,963,146).

As per claim 38, Johnson et al. (Abstract, figure 4, col. 11 lines 21-23) disclose "receiving metered utility data....said metered utility data being representative of energy usage at the location". Johnson et al. (Abstract, figures 1, 4, 11, col. 11 lines 31-37) disclose "processing the metered utility data". Johnson et al. (Abstract, figure 4,

col. 24 lines 6-12, col. 11 lines 21-25, col. 12 lines 30-45) disclose "outputting a cumulative, real-time measurement of usage of a customer's metered utilities".

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (5,963,146) in view of Kelley et al. (6,088,659).

As per claim 40, Johnson et al. (Abstract, figure 4, col. 11 lines 21-23) disclose "at least two utility meters, the at least two utilities meters comprising an electric meter, a water meter, and a gas meter measuring the energy usage...and

outputting a load profile of said energy usage". Johnson et al. (Abstract, figure 4, col. 11 lines 31-37) disclose " a wide area communications network responsively connected to said at least two utility meters which transfers the load profile to the energy information service provider". Johnson et al. (Abstract, figures 1, 4, 11, col. 11 lines 31-37) disclose "a processor system...which processes the load profile". It appears though that Johnson et al. does not clearly disclose "a gateway platform system including software and databases that enable translation of the load profile....into a format that is capable of processing by the energy information service provider". However, Kelley et al. (see at least abstract) teach this excepted feature. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply the techniques of Kelley et al. to the invention of Johnson et al. as specified above because as taught by Kelley et al. (col. 5 lines 48-51) it would enable energy providers to capture consumption and interval meter data for hundreds of thousands of meters, deliver it directly to business functions like billing or CIS, and supply the data to large commercial and industrial accounts.

13. Claims 35-37, 39, 41 and 48-51 are allowed subject to the appropriate correction of the 37 C.F.R. 1.75(a) objections noted in paragraph 5 above.

Claims 26, 28, 29 and 42 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and subject to the appropriate correction of the 37 C.F.R. 1.75(a) objections noted in paragraph 5 above.

14. The following references are cited as being art of general interest: Carpenter (6,199,068) which disclose a mapping interface for a distributed server to translate between dissimilar file formats, Montgomery et al. (6,401,081) which disclose that there was pressure in the prior art to support a large number of different metering devices, i.e., electric, water, gas, and heat metering devices and Ardalan et al. (6,396,839) which disclose the TCP/IP protocol suite being incorporated into a gateway serving multiple meters.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hal D. Wachsman whose telephone number is 571-272-2225. The examiner can normally be reached on Monday to Friday 7:00 A.M. to 4:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc Hoff can be reached on 571-272-2216. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hal D Wachsman
Primary Examiner
Art Unit 2857

HW
February 16, 2005